FILE COPY

Office-Supreme Court, U.S.
FILED
DEC 31 1959
JAMES R. BROWNING, Clerk

In the Supreme Court of the United States

OCTOBER TERM, 1959.

No. 622

DON L. RUBENFIELD,
Petitioner,

vs.

ROBERT C. WATSON,
Commissioner of Patents,
Respondent.

PETITION FOR A WRIT OF CERTIORARI
To the United States Court of
Customs and Patent Appeals.

BRUCE B. KROST,
1386 Union Commerce Bldg.,
Cleveland 14, Ohio,
Attorney for Petitioner.

THE GATES LEGAL PUBLISHING CO., CLEVELAND, OHIO—MAIN 1-8647

TABLE OF CONTENTS.

Citations to Opinion Below 1

Jurisdiction 1

Question Presented 2

Statutes and Patent Office Rules Involved 2

Statement 2

Reasons for Granting the Writ 6

Conclusion 14

APPENDICES:

A. Opinion of the Court of Customs and Patent Appeals 15

B. Judgment of the Court of Customs and Patent Appeals 24

C. Pertinent Statutes 25

D. Pertinent Patent Office Rules 27

TABLE OF AUTHORITIES.

Cases.

Eppinger, In re, 25 CCPA 843, 94 F. 2nd 401, 36 USPQ 325 ..... 10, 11

U. S. ex rel. Steinmetz v. Allen, 192 U. S. 543; 24 S. Ct. 416 (1904) 11, 12-14

Statutes.

28 U. S. C. 1256 1

35 U. S. C. 112 ..... 2, 6, 9, 25

35 U. S. C. 121 ..... 2, 6, 7, 9, 25

35 U. S. C. 171 ..... 2, 6, 10, 26

35 U. S. C. 173 ..... 2, 6, 26

Patent Office Rules.

Rule 75	2, 7, 8, 9, 27
Rule 141 (Former Rule 41)	11, 12, 14
Rule 153	2, 4, 5, 14, 27

In the Supreme Court of the United States

OCTOBER TERM, 1959.

No.

IN THE MATTER OF THE APPLICATION OF
DON L. RUBENFIELD.

PETITION FOR A WRIT OF CERTIORARI
To the United States Court of
Customs and Patent Appeals.

Don L. Rubinfield prays that a writ of certiorari issue to review the judgment of the United States Court of Customs and Patent Appeals, entered in the above-entitled case on October 15, 1959. The decision upon which said judgment is based was given in an opinion dated May 22, 1959. A petition for rehearing was denied on October 6, 1959.

CITATIONS TO OPINION BELOW.

The opinion of the Court of Customs and Patent Appeals is printed in the Appendix A and was reported in 47 CCPA ; 123 USPQ 210; 270 F. 2d 391. The judgment entered on October 15, 1959 is printed in Appendix B.

JURISDICTION.

The judgment of the Court of Customs and Patent Appeals was entered October 15, 1959 (Appendix B). A Petition For Rehearing of the decision in an opinion dated May 22, 1959 (Appendix A) was denied October 6, 1959. The jurisdiction of this Court is invoked under 28 USC Section 1256.

QUESTION PRESENTED.

Whether by an arbitrary rule of the United States Patent Office applicable to all design patent applications, an applicant for a design patent showing in his application more than one embodiment or modification of his design invention may be limited to but a single patent claim without consideration of the differences in kind or degree that may appear in the plurality of design embodiments or modifications shown.

STATUTES AND PATENT OFFICE RULES INVOLVED.

The statutory provisions involved are 35 USC 112; 35 USC 121; 35 USC 171 and 35 USC 173. They are printed in Appendix C.

The Patent Office Rules involved are Rule 75 and Rule 153. They are printed in Appendix D.

STATEMENT.

On October 29, 1954, petitioner filed in the United States Patent Office his application Serial No. D-32,875 for a patent upon his design invention for a floor waxer.

This design application (R. 3) discloses a design for an article of manufacture, to-wit: a floor waxer. One form of the design is illustrated in Figures 1 to 4 (R. 7) and another form of the design is illustrated in Figures 5 to 8 (R. 9) of the drawing. There are three claims (R. 28) in the application: claim 1 directed to the design as shown in Figures 1 to 4; claim 2 directed to the design as shown in Figures 5 to 8; and claim 3 directed to the design having the common appearance as shown in Figures 1 to 8.

The Patent Office Examiner on September 29, 1955 finally rejected all claims "on the ground that a multiplicity of designs is *claimed*"* (R. 11).

---

* Emphasis added throughout unless otherwise indicated.

No action was given on the merits, that is, concerning the patentable novelty of the design. Neither was there a requirement for restriction of the application to one of two independent inventions. No determination was made by the Examiner as to whether there was but one design invention or two design inventions disclosed and claimed in the application.

On appeal to the Patent Office Board of Appeals, the decision of the Examiner was affirmed by the Board (R. 20-24).

On appeal to the United States Court of Patent Appeals, the decision of the Board of Appeals was affirmed in the Court's decision of May 22, 1959 (Appendix A). The Court said:

> "No references have been cited and there is no issue as to whether appellant's designs involve patentable invention.
>
> "The exact ground on which the claims were rejected is somewhat obscure. * * *
>
> * * * * *
>
> "The board in its opinion stated the ground of rejection as being 'that a multiplicity of designs are claimed' and limited its discussion to the *disclosure* of two embodiments of the design, no express statement being made that plural *claiming* was bad per se. However, since the examiner raised the issue of multiple claiming as well as multiple disclosure, and since the board entered a general affirmance of the examiner's decision, the former issue is before this court as well as the latter." (Emphasis by the Court.) (Appendix A, pp. 15, 16.)

The Court below pointed out that the decision was made without regard to the kind or degree of differences between the two embodiments disclosed, by the observation:

"In rejecting the claims as being based on a multiplicity of designs, the Patent Office tribunals did not rely in any way on the extent or nature of the differences between the two embodiments shown in appellant's application, * * *" (Appendix A, p. 16).

Insofar as the rejection by the Patent Office was based on a multiplicity of disclosures (the two forms of design for a floor waxer), the Court below disagreed with the Patent Office and ruled that ground of rejection improper, the Court stating:

"For the reasons given, we are of the opinion that it cannot be stated as an invariable rule that a design application cannot disclose more than one embodiment of the design. Whether such disclosure is improper must depend upon the particular circumstances of the individual case involved, and a blanket rejection on the ground of 'multiplicity', without considering such circumstances, is not proper. On this particular point we are unable to agree with the board.

"It remains to be determined whether, regardless of disclosure, the rejection can be sustained on the ground that a single claim only is permissible in a design application." (Appendix A, p. 21.)

The Court then went on to hold on the basis of Patent Office Rule 153 that more than one claim was not permissible, noting (Appendix A, p. 22) that, "Patent Office Rule 153, relating to design cases, provides that 'More than one claim is not permitted.' "

The Court cited the long-established practice in the Patent Office in support of Rule 153. This custom or practice was said by the Court to be first established by an early decision of the Commissioner of Patents as noted by the Court, as follows:

"Under such circumstances, as was pointed out by the Commissioner in *ex parte Wiessner*, 1898 C. D. 236, 85 O. G. 937, no useful purpose could be served by the inclusion of more than one claim in a design application or patent.

"Since the *Wiessner* decision, it appears to have been the uniform practice of the Patent Office to allow only one claim in a design patent." (Appendix A, p. 23.)

Patent Office Rule 153 (Appendix D), directed to the requirements of applications for design patents, specifies that in design cases: "More than one claim is neither required nor permitted." There is no citation or footnote associated with this rule of any statutory authority in support of the rule.

The Court below conceived that, although a design patent application may disclose or show a plurality of embodiments or modifications of design invention, only a single claim should be permitted in design patents, as illustrated by its statement:

"We find no sound reason for disturbing the long-standing practice of the Patent Office, embodied in Rule 153, which limits design applications to a single claim.

"The decision of the Board of Appeals must, therefore, be affirmed insofar as it is predicated on the ground that plural claims cannot be allowed" (Appendix A, p. 24.)

The effect of the decision of the Court of Customs and Patent Appeals was to overrule as without legal basis the long-standing practice of the Patent Office which limited the *disclosure* in design patent applications to a single embodiment or modification of design invention, but to permit to remain in force the long-standing practice of the Patent Office, as expressed in Patent Office Rule 153, to

limit design patent applications in *all* cases (regardless of the number of modifications and regardless of the degree and kind of distinctions between them) to but a *single* claim.

REASONS FOR GRANTING THE WRIT.

1. The decision below has, without legal basis, rendered null and void the mandate of 35 U. S. C. 171 (Appendix C, p. 26), which states that "The provisions of this title *shall apply* to patents for designs, except* as otherwise provided," in the following respects:

(a) The decision has rendered ineffective and inapplicable to *all* design cases the provisions of 35 U. S. C. 121 (Appendix C, p. 25), because that statute by its own words is operative only

> "If two or more independent and distinct inventions are *claimed* in one application * * *,"

and because division and restriction under that statute inherently and in practice involves a division and restriction as between *claimed* inventions.

(b) The decision has rendered ineffective and inapplicable to *all* design cases the provisions of 35 U. S. C. 112 (Appendix C, p. 25), because that statute by its own words requires and permits:

> "The specification shall conclude with *one or more claims* particularly pointing out and distinctly claiming the subject matter which the *applicant regards* as his invention,"

and which statute entitles all applicants to submit to the Patent Office for its full consideration upon the facts existing in each case such claims (one or more)

---

* Some statutory exceptions are the differing terms of duration for design patents (35 U. S. C. 173) and the requirement for an ornamental appearance rather than usefulness (35 U. S. C. 171), none of which are pertinent here.

as an applicant regards proper "for particularly pointing out and distinctly claiming * * * his invention," under the general limitation of Patent Office Rule 75 (Appendix D, p. 27) that "(b) More than one claim may be presented provided *they* differ substantially from each other and are not unduly multiplied."

2. The decision has wrongfully deprived this design patent applicant of substantial legal rights available to non-design patent applicants, without statutory basis for the distinction in treatment, in the following respects:

(a) In non-design cases, an applicant who has had his application subjected to a holding of the Patent Office under the authority of 35 U. S. C. 121 (Appendix C, p. 25) that "two or more independent and distinct inventions" are *claimed* therein, and who in compliance therewith restricts the application to one claimed invention, and files a divisional application on the other claimed invention, has the *statutory protection* that the patents issuing under each of the two applications shall not be used as references against each other, the statutory protection being found in said 35 U. S. C. 121, as follows:

> "A patent issuing on an application with respect to which a requirement for restriction under this section has been made, or on an application filed as a result of such requirement, *shall not be used* as a reference either in the Patent Office or in the courts against a divisional application or against the original application or any patent issues on either of them, if the divisional application is filed before the issuance of the patent on the other application. * * *"

which statutory protection is denied to all design applicants because of the Court's decision giving ap-

proval to the practice of limiting all design applicants to a single claim.

(b) In non-design cases an applicant who discloses, for example, two species of his invention (as the applicant in this case disclosed two modifications) is entitled under the practice governing all non-design cases to obtain a patent which includes a claim covering one species only, a claim covering the other species only, and a generic claim covering both species (assuming that the claims would "differ substantially" under the criterion of Patent Office Rule 75, Appendix D, p. 27), and thereafter in a suit for infringement of the non-design patent, if the generic claim or one of the species claims is invalidated by the prior art, the patentee is still left with the protection afforded by the remaining non-invalidated claim, but which residual protection is denied to a design patentee, (regardless of the differences in kind and degree between different embodiments or modifications of his design invention disclosed) because of the absolute prohibition against plural claims in all design cases under the long-standing practice of the Patent Office left in effect by the decision below.

3. The decision below deprives the Patent Office of an authority and means of orderly procedure granted to the Patent Office by the statutes (with accompanying provisions for protection of applicants) and hence makes for confusion and lack of uniformity in procedure in the handling of design patent applications by the Patent Office in the following respects:

(a) Upon a design patent applicant *disclosing* a plurality of embodiments or modifications (as now authorized under the decision below), but with a *single* claim, such as "The ornamental design for a

floor waxer substantially as shown," as suggested by the decision below (Appendix A, p. 23), the Patent Office has *no authority or basis* for requiring the design applicant to restrict the application to one of the disclosed embodiments or modifications, *regardless* of how differing in kind and degree those disclosed embodiments or modifications may be in any case, because said 35 U. S. C. 121 (Appendix C, p. 25). applies only where "two or more independent and distinct inventions are *claimed* in one application," and hence is inapplicable to a design patent application disclosing a plurality of modifications or embodiments of design invention but presenting but a single claim to everything shown.

(b) Upon a design patent applicant *disclosing* a plurality of embodiments or modifications (as now authorized under the decision below), but having (assumed for purposes of argument) only inconsequential and unsubstantial differences between the embodiments or modifications shown, but with a *single* claim, such as "The ornamental design for a floor waxer substantially as shown" as suggested by the decision below (Appendix A, p. 23), the Patent Office has no authority or basis for holding that the plurality of embodiments or modifications do not "differ substantially from each other" because the criterion of Patent Office Rule 75 (Appendix D, p. 27), administering the provisions of 35 U. S. C. 112 (Appendix C, p. 25), is only that multiple *claims* "differ substantially from each other," and there is no other basis under the law for ruling out inconsequential and unsubstantial differences.

(c) Upon the Patent Office being called upon to rule upon "units of invention," either to rule (1) upon whether there are "two or more independent

and distinct inventions" or (2) upon whether the invention disclosures "differ substantially from each other," in any case, either design or non-design applications, the only "units of invention" recognized by the statutes are claims, and it is only "units of invention" in the form of *claims* which are capable of being handled in ruling upon such questions in procedure in the Patent Office.

4. The decision below in sustaining Patent Office Rule 153 on the basis of a "long-standing practice" in the Patent Office is without legal support and is contrary to authority in the following respects:

(a) No statute was or could be cited in support of Rule 153, and there was ignored the statutory instruction of 35 U. S. C. 171 (Appendix C, p. 26) that "The provision of this title *shall apply* to patents for design, except as otherwise provided."

(b) The only "authority" cited by the Court below (Appendix A, p. 23) in support of its decision approving the rule allowing but a single claim in all design cases, *other than* decisions from within the Patent Office itself, was the earlier decision of the Court below in the case of *In re Eppinger*, 25 CCPA 843, 94 F. 2nd 401, 36 USPQ 325, containing *dicta* which seemed to approve the single-claim rule of the Patent Office upon the "authority" of a decision of the Patent Office itself and the then current Patent Office rules, in the following quotation from the *In re Eppinger* decision:

"* * * In passing it may be proper to say that appellant's specification and form of claims is quite unusual. It seems to us that the suggestion of the examiner that appellant was entitled to but one

claim, in substantially the form as was suggested, was proper. *Ex parte Hopkins, Jr.* 1923 C. D. 105. See Rules of Practice in the United States Patent Office Nos. 81, 82, and 84; also form of design application prescribed by the rules." (Appendix A, p. 23.)

However, in the *Eppinger* case, there had been disclosed but a *single* embodiment of the invention and so the question of a plurality of claims to cover a plurality of embodiments did not arise. The issue present in the instant case was not there presented. Further, that application had been denied for want of patentable invention over the prior art and this holding was affirmed, making unnecessary the Court's comment on the single claim rule.

There is therefore no controlling authority to support the decision below approving the single-claim rule on the basis of "long-standing practice of the Patent Office" in *all* design cases, including applications disclosing a plurality of embodiments of the design invention.

5. The decision below is in direct conflict with the decision of this Court in the 1904 case of *U. S. ex rel. Steinmetz v. Allen*, 192 U. S. 543; 24 S. Ct. 416. In the *Steinmetz* case, the Patent Office had a "long established practice" and a then current Rule 41* expressing that long

---

* Then current Patent Office Rule 41 (in its present form is Rule 141) provided:

"Two or more independent inventions cannot be claimed in one application; but where several distinct inventions are dependent upon each other and mutually contribute to produce a single result, they may be claimed in one application.

* * * * *

"Claims for a machine and the process in the performance of which the machine is used *must be presented in separate applications.*"

established practice which arbitrarily prohibited inclusion in one application claims on a process and claims on apparatus regardless of how closely the process and apparatus were factually related or associated in any particular application. In rejecting the Steinmetz application, the Patent Office had relied upon that "long established practice" and the then current Rule 41 in defense of its position. This Court was not then persuaded that age of an error was a justification for perpetuating the error and held the "long established practice" to be wrong and the rule of practice to be invalid. This Court in overruling the Patent Office in the *Steinmetz* case stated:

> "Can it be said that a process and an apparatus are inevitably so independent as never to be 'connected in their design and operation'? They may be completely independent. *Cochrane v. Deener*, 94 U. S. 780. But they may be related. They may approach each other so nearly that it will be difficult to distinguish the process from the function of the apparatus. In such case, the apparatus would be the dominant thing. But the dominance may be reversed and the process carry an exclusive right, no matter what apparatus may be devised to perform it.
>
> "If there is a divergence of views between courts and the Patent Office and the divergence proceeds from a different interpretation of the statute, the views of the courts ought to prevail. If the courts, however, have only recognized and enforced the exercise of a discretion of the Patent Office, the question occurs, what is the extent of such discretion and can it be expressed and fixed in an inflexible rule such as rule 41?
>
> * * * * *
>
> "Some discretion is not unlimited discretion, and if the discretion be not unlimited it is reviewable. In other words, the statute gives the right to join inventions in one application in cases where the in-

ventions are related, and it cannot be denied by a hard and fixed rule which prevents such joinder in all cases. Such a rule is not the exercise of discretion; it is a determination not to hear. No inventor can reach the point of invoking the discretion of the Patent Office. He is notified in advance that he will not be heard, no matter what he might be able to show. His right is denied, therefore, not regulated. Such is the necessary effect of rule 41, as amended.

"Without that rule the action of the Patent Office can be accommodated to the character of inventions, and discretion can be exercised, and when exercised, we may say in passing, except in cases of clear abuse, the courts will not review it. But the rule as amended, as we have said, precludes the exercise of any judgment and compels the separation of claims for a process and claims for its apparatus, however related or connected they may be. And the right denied is substantial.

* * * * *

"The Patent Office has not been consistent in its views in regard to the division of inventions. At times convenience of administration has seemed to be of greatest concern; at other times more anxiety has been shown for the rights of inventors. The policy of the office has been denominated that of 'battledore and shuttlecock,' and rule 41 as it now exists was enacted to give simplicity and uniformity to the practice of the office. Its enactment was attempted to be justified by the assumption that the patent laws gave to the office a discretion to permit or deny a joinder of inventions. But, as we have already said, to establish a rule applicable to all cases is not to exercise discretion. Such a rule ignores the differences which invoke discretion, and which can alone justify its exercise, and we are of the opinion therefore that rule 41 is an invalid regulation."

U. S. ex rel. Steinmetz v. Allen, 192 U. S. 543, 559, 560, 561, 563 (1904).

From the above it is demonstrated that the holding in the decision below is diametrically opposed to the law enunciated by this Court in the *Steinmetz* case. Just as the "long established practice" was wrong and unauthorized in that case, so, too, is the "long-standing practice" wrong and unauthorized in the instant case. Just as then current Rule 41 was then held invalid, so, too, Patent Office Rule 153 should be held invalid here.

CONCLUSION.

The petition for a writ of certiorari should be granted for the foregoing reasons.

Respectfully submitted,

BRUCE B. KROST,

Attorney for Petitioner.

December, 1959.

APPENDIX A.

OPINION OF THE COURT OF CUSTOMS AND PATENT APPEALS.

WORLEY, *Chief Judge*.

This is an appeal from the decision of the Board of Appeals of the United States Patent Office affirming the Primary Examiner's rejection of the three claims of appellant's application for a patent on a design for a floor waxer. The appealed claims are as follows:

> 1. The ornamental design for a Floor Waxer substantially as shown in Figures 1 to 4, inclusive.
>
> 2. The ornamental design for a Floor Waxer substantially as shown in Figures 5 to 8, inclusive.
>
> 3. The ornamental design for a Floor Waxer having the common appearance substantially as shown in Figures 1 to 8, inclusive.

Appellant's application discloses designs of two floor waxers of generally similar but specifically different appearance, one being shown in Figures 1 to 4 and the other in Figures 5 to 8.

No references have been cited and there is no issue as to whether appellant's designs involve patentable invention.

The exact ground on which the claims were rejected is somewhat obscure. In his final rejection, the examiner made the following statement:

> It is again noted that the application contains three claims which is not permissible in a design application. See Rule 153 of the Rules of Practice.
>
> The claims are therefore again and FINALLY rejected on the ground that a multiplicity of designs is claimed.

In the examiner's answer to the appeal to the board, it is said that:

> The examiner in the case has finally rejected the claims since the application does not comply with the statute as now interpreted, in that it includes more than a single claim and is directed to more than a single article. * * *
>
> The final rejection on the ground that a multiplicity of designs is claimed is deemed proper and in order.

The board in its opinion stated the ground of rejection as being "that a multiplicity of designs are claimed" and limited its discussion to the *disclosure* of two embodiments of the design, no express statement being made that plural *claiming* was bad per se. However, since the examiner raised the issue of multiple claiming as well as multiple disclosure, and since the board entered a general affirmance of the examiner's decision, the former issue is before this Court as well as the latter. *In re Wagenhorst*, 20 C. C. P. A. 991, 64 F. 2d 780, 17 U. S. P. Q. 330; *In re Wahl*, 30 C. C. P. A. 719, 132 F. 2d 323, 56 U. S. P. Q. 158. It is noted that appellant's eighth reason of appeal here is that "The Board of Appeals erred in holding in effect that a design application could not include more than one claim."

In rejecting the claims as being based on a multiplicity of designs, the Patent Office tribunals did not rely in any way on the extent or nature of the differences between the two embodiments shown in appellant's application, but based their rejection on the proposition that two different embodiments can never properly be illustrated in a design application. In support of that proposition it is urged that since 35 U. S. C. 171 provides for a patent on a design for "an article of manufacture," rather than a plurality of such articles, and since the total substance of a design rests in its appearance as a whole, a single patent cannot be based upon a showing of two or more different designs for an article, no matter how similar they may be.

It is not apparent that 35 U. S. C. 171, relating to design inventions, is any more limited to a single article or form of article, than is 35 U. S. C. 101, relating to inventions of other kinds. The former refers to "any new, original and ornamental design for an article of manufacture" and the latter to "any new and useful process, machine, manufacture, or composition of matter." Neither of the quoted expressions includes any plural term, and yet a plurality of specifically different processes, machines, manufactures, and compositions of matter, so long as they are embodiments of a single invention, are commonly described and claimed in a single patent. Since the language of 35 U. S. C. 101 does not preclude that practice, we see no reason why the similar language of 35 U. S. C. 171 should, per se, preclude the showing of two or more embodiments of a design invention.

In connection with its statement that the total substance of a design rests in its appearance, the board said the practice was firmly established that "design inventions cover 'an article of manufacture' in the sense presented by its appearance or physical shape rather than in the sense that the invention is a theme of decoration or a mental creation of the inventor that is only presented in the patent by way of an illustrative embodiment." If the quoted statement means that a design invention can exist only in some one specific physical embodiment, we are unable to agree with it.

It is well settled that a design patent may be infringed by articles which are specifically different from that shown in the patent, *Gorham Co. v. White*, 81 U. S. 511; *Borgfeldt & Co. v. Weiss*, 265 Fed. 268, and it has been repeatedly held that a patent will be refused on an application claiming a design which is not patentably different from, or involves the same inventive concept as, a design

claimed in a patent granted to the same inventor, even on a copending application. *In re Bigelow*, 39 C. C. P. A. 835, 194 F. 2d 550, 93 U. S. P. Q. 17; *In re Russell*, 44 C. C. P. A. 716, 239 F. 2d 387, 112 U. S. P. Q. 58, and cases there cited. It seems evident, therefore, that the inventive concept of a design is not limited to the exact article which happens to be selected for illustration in an application or patent.

While the exact issue under consideration here has not previously been before this Court, *In re William Schnell*, 18 C. C. P. A. 812, 46 F. 2d 203, 8 U. S. P. Q. 19, contains the following language clearly indicating the opinion that the disclosure of more than one specific embodiment of a design invention in a single application may be proper:

> * * * Furthermore we know of no statutory or other reason why he [a design applicant] may not be permitted to submit drawings of more than one article if his design applies to more than one article and if it seems necessary and essential to use more than one drawing in order that he may teach the manner of applying the same to different articles.
>
> * * * * *
>
> * * * If he is entitled to certain protection under the enforcement provision, why is he not entitled by some appropriate words in the claim and drawing to disclose all that he is entitled to in order that others may be warned of the probable scope of applicant's invention? See *Grant v. Raymond*, 6 Peters 218. As was said in *Ashley v. Tatum Co.*, *supra*, (186 F. 339) "the absence of such a description in the case at bar has a necessary bearing on the construction of the patent and consequently on the question of infringement."

It seems anomalous to hold that two specifically different articles may represent a single inventive concept so

far as double patenting or infringement is concerned, and yet may not be disclosed in a single application.

It appears that the instant rejection, so far as it is based on the fact that the application discloses more than one embodiment of appellant's design, raises a question of form rather than of substance. The designs of Figures 1 to 4 and 5 to 8 differ primarily in that the latter includes certain braces not present in the former. Apparently appellant could have presented a single set of drawings showing the braces in dotted lines, as "immaterial" parts, and seemingly no objection would have been made by the Patent Office, although the substance of the disclosure would have been substantially what it is now. See Sec. 1503.01 M. P. E. P.

It is argued in the brief for the Commissioner that the rejection of the appealed claims was in accordance with the long standing practice of the Patent Office and, therefore, should not be set aside. So far as the limitation of the disclosure to one specific embodiment is concerned, no such settled practice has been shown. With regard to a contention by the Solicitor of the Patent Office in the *Schnell* case that the uniform practice of the Patent Office had, for many years, required "that design patents should be for a single article of manufacture" this Court said:

> * * * We may dispose of this contention of the solicitor, at this point, by saying that in view of rulings in certain cases hereinafter referred to, no such uniform practice in the Patent Office in this respect is shown to have prevailed for a very long period of time. * * *

Later in the opinion cases were cited to support the quoted statement. No Patent Office decisions of a date subsequent to that in the *Schnell* case have been cited here, and accordingly, there is no more evidence as to any long standing practice now than there was then.

It is true that the Patent Office has, on some occasions, held that only one species of a design invention may be disclosed in an application. In one such case, *Ex parte Kahn*, 1905 C. D. 212, 116 O. G. 2008, the Commissioner quoted, with approval, the following statement from *Feder v. Poyet*, 1899 C. D. 218, 89 O. G. 1343:

> * * * If an inventor has a generic design capable of modification—that is, a design made up of a small number of simple elements to which other elements may be added without modification of the essential elements—he should, in order to secure protection for the generic design, show the design in his application in its simplest form. He must show the genus stripped of additions. * * *

The quoted language seems to us to be unrealistic since it requires the inventor to decide, at his peril, which features of his design are "essential," and to limit his application to them, instead of showing the actual design in its final form.

It is also to be noted that the difference between embodiments of a design invention may take the form of modification of the shape of one or more elements rather than an addition of elements. In such a case it cannot properly be said that one embodiment is generic and another specific.

Another theory on which the Patent Office has refused to allow the disclosure of more than one embodiment of a design invention is set forth in the following quotation from the decision of the Commissioner in *Ex parte Hill & Renner*, 1898 C. D. 38, 82 O. G. 1988:

> If an applicant be of the opinion that two or more shapes are one and the same design, he should show only one such shape in his application, leaving the courts to determine whether the other shapes are the same design as that shown in his patent and whether

they infringe such shape or design. (*Ex parte Petzold*, C. D., 1891, 97; 55 O. G., 1652; and *ex parte Hess and Hess*, C. D., 1891, 142; 56 O. G., 1334.) If the different shapes are different designs, different patents should be obtained to cover them.

As above indicated, when similar designs or embodiments are presented by an inventor in separate applications, the Patent Office does not leave the determination as to whether they are distinct inventions to the courts, but, if it finds only one inventive concept to be involved, allows a patent on one application and rejects the others on the ground of double patenting. It is not apparent, therefore, why that office should refuse to undertake a similar determination when different embodiments are presented in a single application. No doubt, as was said by the Commissioner in *Ex parte Lunken*, 1896 C. D. 22, 76 O. G. 785, "it would be convenient for the office to dispose of the question summarily by requiring but one invariable form to be shown and patented" but as was further, and we think correctly, pointed out by the Commissioner in that case, such convenience cannot take precedence over the rights of applicants.

For the reasons given, we are of the opinion that it cannot be stated as an invariable rule that a design application cannot disclose more than one embodiment of the design. Whether such disclosure is improper must depend upon the particular circumstances of the individual case involved, and a blanket rejection on the ground of "multiplicity," without considering such circumstances, is not proper. On this particular point we are unable to agree with the board.

It remains to be determined whether, regardless of disclosure, the rejection can be sustained on the ground that a single claim only is permissible in a design application.

Patent Office Rule 153, relating to design cases, provides that "More than one claim is not permitted." As was pointed out in *United States, ex rel. Steinmetz v. Allen, Commissioner of Patents*, 104 O. G., 853, 1903 C. D. 578, 22 App. D. C. 56, the rules of the Patent Office have the force and effect of law unless they are inconsistent with statutory provisions. In that case, the court said:

> If there be no such inconsistency with the express provisions of the statute the rules are valid and have the force and effect of law in all matters to which they relate. They are certainly not to be declared invalid upon any consideration of doubtful construction, but only for such conflict or inconsistency with the statute law upon the subject as shall be made plainly to appear. * * *

We are unable to find any clear conflict between Rule 153 and the applicable statutes. Title 35, section 171 of the United States Code provides that "The provisions of this title relating to patents for inventions shall apply to patents for designs, except as otherwise provided." While 35 U. S. C. 112 states that "The specification shall conclude with one or more claims," that provision does not necessarily mean that every applicant shall, as a matter of right, be entitled to present a plurality of claims regardless of the nature of the invention involved. Similarly, 35 U. S. C. 121, on which appellant relies heavily, contains no express provision that every applicant is entitled to more than one claim, but sets forth the practice which the Commissioner may follow when claims to two or more independent and distinct inventions are presented.

It has been consistently held for many years that it is the appearance of a design as a whole which is controlling in determining questions of patentability and infringement. *Gorham Company v. White*, 81 U. S. 511; *In re Schraubstadter*, 26 App. D. C. 331, 1906 C. D. 541; *In re*

Bonnell, 29 C. C. P. A. 1104, 129 F. 2d 520, 54 U. S. P. Q. 202; *In re Campbell*, 41 C. C. P. A. 896, 212 F. 2d 606, 101 U. S. P. Q. 406; and *In re Russell*, 44 C. C. P. A. 716, 239 F. 2d 387, 112 U. S. P. Q. 58. Under such circumstances, as was pointed out by the Commissioner in *ex parte Wiessner*, 1898 C. D. 236, 85 O. G. 937, no useful purpose could be served by the inclusion of more than one claim in a design application or patent.

Since the *Wiessner* decision, it appears to have been the uniform practice of the Patent Office to allow only one claim in a design patent. See Symons, *The Law of Patents for Designs* (1914), page 88; *Walker on Patents*, Deller's Edition (1937) page 414. That practice was, in effect, approved by this Court in *In re Eppinger*, 25 C. C. P. A. 843, 94 F. 2d 401, 36 U. S. P. Q. 325, where the court said:

> * * * In passing it may be proper to say that appellant's specification and form of claims is quite unusual. It seems to us that the suggestion of the examiner that appellant was entitled to but one claim, in substantially the form as was suggested, was proper. *Ex parte Hopkins, Jr.* 1923 C. D. 105. See Rules of Practice in the United States Patent Office Nos. 81, 82, and 84; also form of design application prescribed by the rules.

The fact that it may be permissible, in a proper case, to illustrate more than one embodiment of a design invention does not require or justify more than one claim. Such embodiments can be presented only if they involve a single inventive concept; and such a concept can be protected by a single claim. A single claim to "The ornamental design for a floor waxer substantially as shown" would afford exactly the same degree of protection to appellant in the instant case as would the three claims involved in this appeal.

A so-called generic claim, such as claim 3 of the instant application, covering the "common appearance" of two modifications, is apparently directed to some broad concept which is not illustrated. Such a claim is indefinite and has no proper place in a design application. An applicant for a design patent cannot properly illustrate two designs on the theory that they represent embodiments of a single invention and, at the same time, claim them separately as representing different inventive concepts.

We find no sound reason for disturbing the long-standing practice of the Patent Office, embodied in Rule 153, which limits design applications to a single claim.

The decision of the Board of Appeals must, therefore, be affirmed insofar as it is predicated on the ground that plural claims cannot be allowed.

AFFIRMED.

Johnson, J., Retired, concurs in result.

Johnson, J., Retired, recalled to participate.

APPENDIX B.

JUDGMENT OF THE COURT OF CUSTOMS AND PATENT APPEALS.

Said appeal having heretofore been brought on to be heard before the court and due consideration thereon having been had, it is—

ORDERED that the decision of the Board of Appeals be, and the same is hereby, affirmed.

APPENDIX C.

PERTINENT STATUTES.

35 U. S. C. 112—Specification

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

An element in a claim for a combination may be expressed as a means or step performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.

35 U. S. C. 121—Divisional applications

If two or more independent and distinct inventions are claimed in one application, the Commissioner may require the application to be restricted to one of the inventions. If the other invention is made the subject of a divisional application which complies with the requirements of section 120 of this title it shall be entitled to the benefit of the filing date of the original application. A patent issuing on an application with respect to which a requirement for restriction under this section has been made, or on an application filed as a result of such a requirement, shall not be used as a reference either in the Patent Office

or in the courts against a divisional application or against the original application or any patent issued on either of them, if the divisional application is filed before the issuance of the patent on the other application. If a divisional application is directed solely to subject matter described and claimed in the original application as filed, the Commissioner may dispense with signing and execution by the inventor. The validity of a patent shall not be questioned for failure of the Commissioner to require the application to be restricted to one invention.

35 U. S. C. 171—Patents for designs

Whoever invents any new, original and ornamental design for an article of manufacture may obtain a patent therefor, subject to the conditions and requirements of this title.

The provisions of this title relating to patents for inventions shall apply to patents for designs, except as otherwise provided.

35 U. S. C. 173—Term of design patent

Patents for designs may be granted for the term of three years and six months, or for seven years, or for fourteen years, as the applicant, in his application, elects.

APPENDIX D.

PERTINENT PATENT OFFICE RULES.

75. *Claim.* (a) The specification must conclude with a claim particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention or discovery.

(b) More than one claim may be presented, provided they differ substantially from each other and are not unduly multiplied.

(c) When more than one claim is presented, they may be placed in dependent form in which a claim may refer back to and further restrict a single preceding claim.

(d) The claim or claims must conform to the invention as set forth in the remainder of the specification and the terms and phrases used in the claims must find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description.

See rules 141 to 147 as to claiming different inventions in one application.

153. *Title, description and claim, oath.* The title of the design must designate the particular article. No description, other than a reference to the drawing, is ordinarily required. The claim shall be in formal terms to the ornamental design for the article (specifying name) as shown, or as shown and described. More than one claim is neither required nor permitted.

The oath required of the applicant must comply with rule 65 except that the period of twelve months specified therein with respect to foreign applications is six months in the case of designs.